

REMARKS

Through this paper, claims 6, 18, 49, 64, and 65, are canceled without prejudice. Also, claims 1-4, 7, 8, 11, 17, 20, 21, 28, 29, 44-46, 50, 51, 54, 59, 66, 68, 74, and 75 have been amended. Among them, claim 1 has been amended to recite an array of probes, each comprising at least one optically detectable probe material. Claim 44 has been amended to recite a method of performing *in vivo* examination of a mammalian body using the body-insertable apparatus recited by amended claim 1. Support for the amendments to claims 1 and 44 can be found in the Specification at, for example, page 6, lines 18-28, and claim 1 as originally filed.

Various changes to the remaining dependent claims are necessitated by the changes to the independent claims 1 and 44, and the claim cancellations. Also, claims 2-4 have been amended to recite “probe material” instead of “probe,” the support of which can be found in the Specification at, for example, page 3, lines 18-28. Claims 11 and 54 have been amended to recite optics that direct light to at least one of the probes or use of such optics, the support of which can be found in the Specification at, for example, page 6, lines 12-14. No new matter is added by these amendments.

Claim Objections

Claims 1-4, 6-24, 26-32, 44-47, and 49-88 have been objected to for informalities. Specifically, the Office action states that the meaning of the recited limitation “probe” is unclear.

In response, Applicant has amended claim 1 to recite *an array of probes*, each comprising at least one optically detectable *probe material*. Applicant has also amended claim 44 in a similar fashion. The remaining objected claims depend from either claim 1 or claim 44, and their claim language has been amended to specify either “probes” or “probe material.” Therefore, Applicant respectfully submits that all the claim objections have been overcome and requests reconsideration and withdrawal of all the claim objections.

Rejections Under 35 U.S.C. § 102

Claims 1, 4, 6, 7, 11, 14, 15, 17-23, 26, 31, 32, 44, 47, 54, 57, 59-64, 66-69, 71, 80, 87, and 88 are rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 5,833,603 to Kovacs *et al.*

("Kovacs"). Claims 1, 27-29, 30, 44, 72, 73 are rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,122,536 to Sun *et al.* ("Sun").

However, the Office action indicates that claim 49, among other claims, are directed to allowable subject matter (Office action, page 6). Claim 49 recites a method of performing *in vivo* examination comprising a step of providing an array of sub-probes. That limitation has been effectively incorporated into amended claim 44 which now recites providing a device comprising an array of probes. Accordingly, Applicant respectfully submits that amended claim 44 and its dependent claims should be allowable over the cited references.

Applicant further submits that the Office action appears to contain a mistake regarding the rejection of claim 6. Claim 6, rejected under 35 U.S.C. § 102(e) over Kovacs, is a device claim with limitations corresponding to those recited in claim 49. Specifically, claim 6 recites a body-insertable apparatus comprising an array of sub-probes. The last paragraph on page 3 of the Office action appears to address the prior art rejection of claim 6, but in fact only discusses limitations recited in claim 17-23 and 64. Applicant further submits that neither Kovacs nor Sun discloses or suggests an array of probes in their respective device. Accordingly, amended claim 1, which effectively includes the additional limitation of claim 6 and recites "an array of probes" each comprising at least one optically detectable probe material, should be allowable over the cited references as well.

Applicant respectfully requests the reconsideration and withdrawal of all the rejections under 35 U.S.C. § 102.

Rejections Under 35 U.S.C. § 103

Claims 2, 3, 45, and 46 are rejected under 35 U.S.C. 103(a) over Kovacs further in view of U.S. Patent No. 5,716,981 to Hunter *et al.* ("Hunter"). Claims 16 and 58 are rejected under 35 U.S.C. 103(a) over Kovacs further in view of U.S. Patent No. 5,408,996 to Salb ("Salb"). Claims 24 and 70 are rejected under 35 U.S.C. 103(a) over Kovacs further in view of U.S. Patent No. 5,412,087 to McGall *et al.* ("McGall"). Claims 27-30, 72, and 74 are rejected under 35 U.S.C. 103(a) over Kovacs further in view of U.S. Patent No. 4,832,034 to Pizziconi *et al.* ("Pizziconi").

Claims 2 and 3 both depend from amended claim 1, and claims 45 and 46 both depend from amended claim 44. As discussed in the previous section, Kovacs does not disclose or suggest an array of probes each comprising at least one optically detectable probe material, a limitation in both amended claims 1 and 44. Hunter describes anti-angiogenic factors used in combination with a polymeric carrier. Salb describes injecting into a patient a fluorescent metabolic agent before an imaging procedure. McGall describes selectively activating protected thiol groups to conduct surface chemistry. Pizziconi describes using a hollow fiber membrane to filter a body fluid for analysis. None of these references discloses or suggests an array of probes each comprising at least one optically detectable probe material, therefore, all the rejections under 35 U.S.C. § 103 have been overcome by the amendments and Applicant respectfully requests the reconsideration and withdrawal of these rejections.

CONCLUSION


After the entry of this paper, claims 1-4, 7-17, 20-24, 26-32, 44-47, 50-63, and 65-88 are pending and presented for reconsideration. In view of the foregoing, please allow the claims in due course.

If the Examiner believes that a telephone conversation with Applicant's attorney would expedite allowance of this application, the Examiner is cordially invited to call the undersigned attorney at (617) 248-7808.

Respectfully submitted,

Date: August 5, 2004
Reg. No. (Limited Recognition)
PTO Customer No. 021323

Tel. No.: (617) 248-7808
Fax No.: (617) 248-7100



Duan Wu
Attorney for Applicant
Testa, Hurwitz, & Thibeault, LLP
High Street Tower
125 High Street
Boston, Massachusetts 02110